

**REMARKS**

The Office Action dated April 4, 2003 has been carefully considered and this Amendment prepared in response. Applicants respectfully request reconsideration of the present application in view of the foregoing amendments and in view of the following remarks.

Claim 1 is amended to include the allowable subject matter of claim 2. Claim 2 is requested to be cancelled without prejudice or disclaimer. A detailed listing of all claims that are, or were, in the application, irrespective of whether the claim(s) remain under examination in the application, are presented, with an appropriate defined status identifier. After amending the claims as set forth above, claims 1 and 3 – 12 are now pending in this application.

In the Office Action, the amendment filed January 29, 2003 was objected to under 35 U.S.C. § 132 for introducing new matter, claims 1 – 11 were rejected under 35 U.S.C. § 112, first paragraph as containing subject matter that was not enabled by the specification, and claims 1, 5 and 9 were rejected under 35 U.S.C. § 102(b) as being anticipated by EP 561,001 to Ishibe. Applicants express their appreciation for the Examiner's statement that claims 2-4 and 6-9 would be allowable if rewritten to overcome the rejections under 35 U.S.C. § 112, first paragraph and to incorporate all claims from which they depend.

**Claims 1 Is Amended To Incorporate Allowable Subject Matter**

Claim 1 is currently amended to incorporate subject matter from claim 2, which is cancelled. Since the Office Action indicates that claim 2 recited allowable subject matter, Applicants believe that claim 1 as amended is not anticipated by the Ishibe reference. Accordingly, Applicants respectfully request withdrawal of the rejection of claim 1 under 35 U.S.C. § 102(b).

Since claims 3-9 depend from claim 1, Applicants believe claims 3-9 also are allowable. Accordingly, Applicants respectfully request withdrawal of the rejections of these claims under 35 U.S.C. § 102(b).

**The Specification Is Amended To Remove Material that is Objected To**

The paragraph on page 10, starting on line 3, had been revised a second time to remove the matter identified by the Examiner as new. Additionally, reference is added to the U.S. patent that corresponds to the British patent originally cited in the application. Since the U.S. patent discloses substantially the same information as the originally cited British patent, this addition does not add new matter.

Since the amendment removes the matter identified by the Examiner as new, Applicants respectfully request withdrawal of the objection under 35 U.S.C. § 132.

**The Rejection Under 35 U.S.C. § 112, First Paragraph Is Traversed**

Applicants respectfully disagree that the specification does not enable one of skill in the art to practice the claimed invention without undue experimentation.

Under 35 U.S.C. § 112, first paragraph, the specification must “contain a written description of the invention . . . as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the [invention].” In determining whether claims are enabled by the specification, several factors should be considered, including (B) the nature of the invention, (C) the state of the prior art, (E) the level of predictability in the art, (F) the amount of direction provided by the inventor, and (H) the quantity of experimentation needed to make or use the invention based on the content of the invention. MPEP § 2164.01(a). A specification is enabling even if a considerable amount of experimentation may be required if the specification provides a reasonable amount of guidance with respect to the direction in which the experimentation should proceed. MPEP § 2164.06 (citing *In re Wands*, 858 F.2d 731 (Fed. Cir. 1988)). Further, patent specifications need not teach, and preferably should omit those elements or steps that are well known to those skilled in the art. MPEP § 2164.01 (citing, *inter alia*, *In re Buchner* 929 F.2d 660, 661 (Fed. Cir. 1991)). Each of these considerations is addressed below.

### **The Nature of the Invention ("B")**

The nature of the invention, and in particular the wire web filter elements, involves mechanical structures made using 30+ year old technology. Such structures were well understood and well known to persons of skill in the art when the application was filed.

### **The State of the Prior Art ("C")**

The specification points out that the methods for making the wire web filter elements are known. Specifically, according to the specification, methods for making the wire used in the web were well known such as disclosed in U.S. Patent No. 3,379,000 (which issued in April 1968). Page 5, first paragraph (which is herein amended). Also, the specification explains that methods of making the web from such wire were well known such as disclosed in British patent specification 1,190,844 (which first published in May 1970). In fact, the methods for making the web was known in this country at least since September 1969 when the corresponding U.S. patent, 3,469,297 issued. Thus, the state of the art with respect to making the wire web was documented in patent publications over 30 years old at the time the present specification was filed. Therefore, the state of the art was very mature and well understood.

### **The Level of Predictability in the Art and the Quantity of Experimentation Needed to Make or Use the Invention ("E" and "H")**

The wire web filter elements, being non-moving mechanical structures, are highly predictable, particularly compared to the chemical and biological arts. Thus, the amount of experimentation required to attain a web with particular properties should be minimal since results of a particular process should be predictable and the effect of process changes to improve the resulting production should also be highly predictable.

### **The Amount of Direction Provided by the Inventor ("F")**

The specification, while leaving out minor steps, provides more than adequate disclosure of the method of making the filter elements. Persons of skill in the art are presumed to have knowledge of all pertinent prior publications, and therefore are presumed to

have known the methods disclosed in the U.S. and British patents. Yet the specification goes the additional step of guiding those of skill in the art to particularly pertinent references. Since those references were well known, being 30 year old patents, it was not necessary to fully disclose in the present specification all the method steps taught in those references. In fact, it was preferable that all those well known steps were omitted. MPEP § 2164.01.

\* \* \* \* \*

As noted above, one of ordinary skill in the art is presumed to know and make use of pertinent references published before the filing date of application. Merely identifying these documents was sufficient to point out their relevance. Further, the British patent is the counter-part of earlier issued U.S. Patent No. 3,469,297, and thus the same disclosure was known in this country even before the British specification was published.

As noted above, the mechanical arts are generally predictable and do not involve a great deal of experimentation. The specification points out two relevant publications, and thus provides specific and enabling guidance to one skilled in the art for making the wire web filter elements. Thus, to the extent that some experimentation might be required, the specification provides specific guidance to one skilled in the art. That guidance could only be more specific if the content of the cited patents had been incorporated into the specification, but, as noted above, that would have been unnecessary and undesirable. MPEP § 2164.01.

In addition to guiding one of skill in the art to pertinent publications, the specification goes on to describe the material and the diameter of the wires used to make the mesh. See page 5, first and second paragraphs. The cited U.S. Patent No. 3,379,000 teaches that such wires have a substantially uniform cross-section but random curvature and a distribution of lengths about a "staple fiber length of at least approximately two inches" and which may range from one-half to six inches. Col. 4, ll. 12-19 and ll. 62-64. Further, the specification teaches additional processing steps for the separate web elements, such as sintering and cold isostatic pressing (page 5, first paragraph), and processing steps for the combined elements, such as sintering under light pressure (page 5, second paragraph). Thus, the specification provides a step by step fabrication process that is fully enabling to one of skill in the art.

Since the specification is more than adequate to enable one of ordinary skill in the art, utilizing the identified 30-year old publications as a guide, to practice the invention without undue experimentation, Applicants respectfully maintain that claims 1-11 are enabled by the specification in accordance with 35 U.S.C. § 112, first paragraph. Accordingly, Applicants respectfully request withdrawal of the rejections of claims 1-11 under 35 U.S.C. § 112, first paragraph.

**New Claim 12**

New claim 12 is allowable for at least the reason that it depends from claim 10, a claim indicated as containing allowable subject matter.

**Conclusion**

Applicants believe that the present application is now in condition for allowance. Favorable reconsideration of the application as amended is respectfully requested.

Examiner Savage is invited to contact the undersigned by telephone if it is felt that a telephone interview would advance the prosecution of the present application.

The Commissioner is hereby authorized to charge any additional fees which may be required regarding this application under 37 C.F.R. §§ 1.16-1.17, or credit any overpayment, to Deposit Account No. 19-0741. Should no proper payment be enclosed herewith, as by a check being in the wrong amount, unsigned, post-dated, otherwise improper or informal or even entirely missing, the Commissioner is authorized to charge the unpaid amount to

Deposit Account No. 19-0741. If any extensions of time are needed for timely acceptance of papers submitted herewith, applicant hereby petitions for such extension under 37 C.F.R. §1.136 and authorizes payment of any such extensions fees to Deposit Account No. 19-0741.

Respectfully submitted,

By 

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